

Remarks/Arguments

Claims 1-21 are now pending in this application. In the April 14, 2005 Office Action, claims 1-4 and 11-14 were rejected under 35 U.S.C. §102 (e) as being anticipated by U.S. Patent No. 6,529,187 to Dickelman (hereinafter "*Dickelman*"). Claims 5-10 and 15-21 were rejected under 35 U.S.C. §103 (a) as being obvious over *Dickelman* in view of U.S. Patent No. 6,392,640 to Will (hereinafter "*Will*"). By this amendment, claim 1 is amended and claims 16, 17, and 21 are canceled. For the reasons set forth below, the applicant respectfully requests reconsideration and immediate allowance of this application.

Independent Claim 1

Independent claim 1 was rejected under 35 U.S.C. §102 (e) as being anticipated by *Dickelman*. The applicant has amended claim 1 to more clearly reflect one aspect of the present invention. The applicant respectfully submits that *Dickelman* fails to teach, suggest, or describe each recitation of amended claim 1. In particular, *Dickelman* does not suggest or describe, "determining whether the at least one character of text includes a period" and "if not, then displaying a list in the web browser with a list item wherein the list item comprises the at least one character of text with an automatic prefix added before the at least one character of text and an automatic suffix added after the at least one character of text" as recited by claim 1.

The April 14, 2005 Office Action suggests that "single word" is not recited in claim 1 as being text without a period. The applicant has removed the term "single word" from claim 1 and amended claim 1 to recite "determining whether the at least one character of text includes a period" and a corresponding action if the text does not include a period. *Dickelman* does not describe these recitations. *Dickelman* describes adding a prefix and suffix to any sequence of letters input by a user, without determining whether the letters include a period or not. Accordingly, for at least this reason, independent claim 1 is allowable over *Dickelman*.

Independent Claim 15

Claim 15 was rejected under 35 U.S.C. §103 (a) as being obvious over *Dickelman* in view of *Will*. The applicant respectfully submits that the cited combination fails to teach, suggest, or

describe, “determining whether the at least one character of text includes a period and, if not, then adding a prefix and a suffix to the at least one character of text to form a combined address and displaying the combined address as an entry in a selection list” and “if the at least one character of text includes a period, then not adding a prefix and a suffix to the at least one character of text to form a combined address and not displaying the combined address as an entry in the selection list” as recited by claim 15.

The applicant amended independent claim 15 in the Amendment and Response submitted on December 1, 2004. The present claim 15, as listed above, is a result of that amendment. The amendment was made as a result of a telephone interview between Examiner Parton and Mike Baldauff and Leonard Hope representing the applicant. During this interview, Examiner Parton indicated that claim 15, as amended, was allowable over *Dickelman* in view of *Will*, but would require an additional search for verification. Examiner Parton issued an Interview Summary on December 6, 2004, which states,

[t]he applicant’s representative submitted a proposed amendment which would overcome the reference to *Dickelman* if filed. The examiner further agreed that the claim appears to be allowable as written, but additional search will be required to verify this. The applicant’s representative agreed to formally submit the amendment for consideration by the examiner.

However, the April 14, 2005 Office Action fails to consider the amendments made by the applicant, discussed during the telephone interview, and agreed upon as overcoming *Dickelman*. In rejecting claim 15, the April 14, 2005 Office Action states on page 8 that *Dickelman* teaches a system with means for “[d]etermining whether the at least one character of text is a single word and if so, then adding a prefix and suffix to the at least one character of text to form a combined address and displaying the combined address as an entry in a selection list.” Claim 15, as amended in the December 1, 2004 Amendment and Response, does not contain this recitation. During a telephone conference on May 6, 2005, Examiner Parton acknowledged that the amendment to claim 15 should have been considered. Consequently, because the April 14, 2005 Office Action fails to reject each recitation of independent claim 15 over prior art, and because *Dickelman* in view of *Will* fails to teach, suggest, or describe each recitation of claim 15 as acknowledged by Examiner Parton in his December 6, 2004 Interview Summary, the applicant

respectfully submits that independent claim 15 is allowable over the prior art of record and is in condition for immediate allowance.

Dependent Claims 2-14 and 18-20

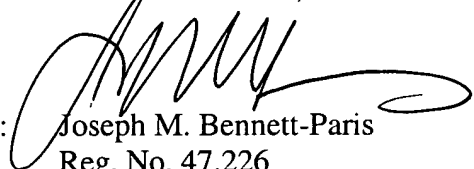
Because the prior art of record fails to teach, suggest, or describe the recitations of claims 2-14 and 18-20, and because claims 2-14 and 18-20 depend from allowable independent claims 1 and 15, dependent claims 2-14 and 18-20 are allowable over the prior art.

Conclusion

In view of the foregoing amendment and remarks, the applicant respectfully submits that the present application is in condition for allowance. Reconsideration and reexamination of the application and allowance of the claims at an early date is solicited. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact the applicant's undersigned attorney at the number below.

Respectfully submitted,

MERCHANT & GOULD, LLC

By: 
Joseph M. Bennett-Paris
Reg. No. 47,226

Date: May 10, 2005

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
Telephone: 404.954.5100

27488

PATENT TRADEMARK OFFICE